

REMARKS/ARGUMENTS

Claims 2-5, 7, 8, and 10-12 remain in this application. Claims 1, 6, and 9 are canceled; claim 12 is new.

Amendments: Lack of New Matter

Applicant submits that the forgoing claim amendments do not introduce new matter into the present application. Currently-amended claim 1 has been amended by inserting the subject matter of originally-filed claim 2 into currently-amended claim 1. The articles recited in new claim 12 are found in the present specification on p. 11, lines 3-6).

Claim 1 over US 6,313,335 (Roberts) in view of US 5,342,882 (Göbel)

In the above-identified Office Action the Examiner rejected claim 2 under 35 USC §103(a) as being obvious over US 6,313,335 (Roberts) in view of US 5,342,882 Göbel. The subject matter of currently-amended claim 1 is the same as the subject matter of then-pending claim 2. In the above-identified Office Action, the Examiner stated that Roberts fails to teach the acid number range specified in currently-amended claim 1 and that Göbel teaches that acid numbers of 5-50 are preferred.

Applicant respectfully asserts that the present invention, as recited in currently-amended independent claim 1, is not obvious over Roberts in view of Göbel. Applicant submits that a person of ordinary skill in the art would not find it obvious to combine the teachings of Göbel and Roberts. Roberts teaches that the coating compositions of his invention are "useful as surface adhesion preventers" (col. 1, line 12). In contrast, Göbel teaches that the coating compositions of his invention are "particularly suitable for use as aqueous basecoats" (col. 18, lines 42-43). Göbel further teaches that the coating compositions of his invention, even after they are dried and heated (col. 18, lines 61-2), can be coated with subsequently-applied lacquer coats (col. 18, lines 63-64), and that the "adherence" (col. 19, line 24) between these coats will be "good" (col. 19, line 25).

In sum, Roberts teaches coatings whose function is prevention of surface adhesion, while Göbel teaches coatings that have good surface adhesion. Therefore, Applicant submits that, because the intended uses of the Roberts-taught coatings and the Göbel-taught coatings are opposite, a person of ordinary skill in the art would conclude that combining the teachings of Roberts and Göbel would destroy the intended function of one or the other. Applicant therefore submits that a person of ordinary skill in the art would not find it obvious to combine the teachings of Roberts and Göbel.

Consequently, Applicant respectfully asserts that the present invention, as recited in currently-amended claim 1, is not obvious over Roberts in view of Göbel.

Claims 3, 4, and 11

Applicants submit that present claims 3, 4, and 11 are also non-obvious, because they are dependent on currently-amended claim 1, which was demonstrated herein above to be non-obvious.

Claims 5, 7, 8, and 10 over Roberts in view of US 4,640,211 (Brandt)

In the above-identified Office Action the Examiner rejected claims 5, 7, 8, and 10 under 35 USC §103(a) as being obvious over Roberts in view of US 4,640,211 (Brandt). The Examiner stated that it would have been obvious to apply the coatings of Roberts' invention to the rope of Brandt's invention.

However, Applicants submit that the coatings recited in currently-amended claims 5, 7, 8, and 10 are distinct from the teachings of Roberts, as demonstrated herein above in the discussion regarding currently amended claim 1, because the coatings recited in currently-amended claims 5, 7, 8, and 10 involve coatings that include polymers with acid number in the range of 5-50. Therefore, Applicants submit that the teachings of Brandt regarding rope do not address any difference between the teachings of Roberts and the subject matter of currently-amended claims 5, 7, 8, and 10. Consequently,

Applicants submit that the present invention, as recited in currently-amended claims 5, 7, 8, and 10, is not obvious over Roberts in view of Brandt.

New claim 12

Applicants submit that new claim 12 is also non-obvious, for the reasons stated herein above regarding currently-amended claims 5, 7, 8, and 10.

Conclusion

In view of the foregoing amendments and arguments, Applicant respectfully requests the Examiner to reexamine the claimed subject matter, to withdraw the rejections of the claimed subject matter, and to allow claims 2-5, 7, 8, 10, 11, and 12 at this time. If, however, there remain any open issues which the Examiner believes can be resolved by a telephone call, the Examiner is cordially invited to contact the undersigned agent.

An fee of \$790 is believed to be due in connection with the Request for Continued Examination, submitted herewith. No additional are believed to be due; however, if any such fees, including petition or extension fees, are due, the Commissioner is hereby authorized to charge them, as well as to credit any overpayments, to Deposit Account No. 18-1850.

Respectfully Submitted,



Carl P. Hemenway
Agent for Applicant
Registration No. 51,798
Tel: 215-619-5242
Fax: 215-619-1612

Rohm and Haas Company
Independence Mall West
Philadelphia, PA 19106-2399

Date: February 01, 2005